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OFFICE OF PETITIONS

In re Application of : DECISION REFUSING STATUS
Rice, et al. : UNDER 37 CFR 1.47(a)
Application No.: 10/017,323 :
Filed: December 13, 2001 :
Attorney Docket No.: 4239-61858 :
For: BENZOYLALKYLINDOLEPYRIDINUM
COMPOUNDS AND PHARMACEUTICAL
COMPOUNDS COMPRISING SUCH
COMPOUNDS

This is a decision on the petition under 37 CFR 1.47(a), filed June 26, 2002 (certificate of mailing date June 20, 2002). The petition was only recently forwarded to the Office of Petitions. The Office apologizes for the delay in addressing the petition.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on December 13, 2001 without an executed oath or declaration. Accordingly, on March 20, 2002, a "Notice to File Missing Parts of Nonprovisional Application" was mailed, requiring an executed oath or declaration, the basic filing fee, a surcharge for their late filing, and substitute drawings.

In response, on June 26, 2002 (certificate of mailing date June 20, 2002), a petition for a one month extension of time and required fee, a declaration executed by 6 of 7 joint inventors, the surcharge, the basic filing fee, substitute drawings, and the instant petition and required fee were filed.

A declaration of facts of Stacey C. Slater, attorney for applicants, accompanied the petition. Attorney Slater explains that non-signing joint inventor, Dr. Vadim Makarov, received an e-mail copy of the application and declaration for the above-identified application and expressly refused to sign the declaration for the patent application via e-mail.

A grantable petition under 37 CFR 1.47(a) requires

- (1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,
- (2) a proper oath or Declaration executed by the available joint inventor(s),
- (3) the fee of \$130 as specified in 37 CFR § 1.17(h), and
- (4) the last known address of the omitted inventor(s).

This petition lacks items (2) and (4) above.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 still has not been presented. The mailing/ post office address of non-signing inventor Makarov is not included on the declaration. The mailing/post office address of each inventor must be included on the oath or declaration. 37 CFR 1.63(c)(1); MPEP 605.03 An e-mail address is not the equivalent of a mailing/post office address. As Dr. Makarov is not executing the declaration, the inventor's most recent home address must be given to enable the Office to communicate directly with the inventor.

All signing inventors must execute another declaration that lists the application serial number and filing date, contains the signers' own information, and lists Dr. Makarov's citizenship, residence, and mailing/post office address. The signing inventors should sign in their respective signature blocks. Dr. Makarov's signature block should be left blank. The Office will interpret this submission as the signing inventors signing the declaration on behalf of Dr. Makarov.

An oath or declaration in compliance with 37 CFR 1.63 and 1.64 signed by the Rule 1.47 applicants on behalf of the non-signing inventor is REQUIRED. See MPEP 409.03(a).

As to item (4), a statement of Dr. Makarov's last known address is missing and required. Further correspondence with respect to this matter should be addressed as follows:

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Telephone inquiries should be directed to the undersigned at (703) 308-6712.



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